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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,542	12/20/2000	Christof Fattinger	9492	6425

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EXAMINER	
QUAN, ELIZABETH S	
ART UNIT	PAPER NUMBER

1743

4

DATE MAILED: 01/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/741,542	FATTINGER ET AL.	
	Examiner Elizabeth Quan	Art Unit 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. 09/156,074.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/156,074, filed on 9/17/98.

***Drawings***

2. The drawings are objected to because line A-A is not shown in FIG. 1 to ensure correct understanding of the cross-sectional view provided in FIG. 2. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Specification***

3. The disclosure is objected to because of the following informalities: On line 5 of page 5 "Celcius" should be replaced by Celsius. For complete understanding degrees could be inserted before Celsius. The sentence on lines 18-20 of page 5 is ambiguous with "containing the compound containing aliquots..."

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,514,343 to Verwohlt et al. in view of U.S. Patent No. 5,048,957 to Berthold et al and in further view of U.S. Patent No. 4,534,465 to Rothermel et al.

Referring to claims 1-5, Verwohlt discloses a microtitration system with a rectangular frame-like holder or tray (10) (see FIG. 1; COL. 4, lines 14-16). The holder (10) has a frame part (11) defining the sides of the holder and a flat wall (12) with apertures (13) for receiving wells (see FIG. 1; COL. 4, lines 18-22). The apertures may have a polygonal shape, such as a rectangle or square (see COL. 2, lines 13-14). The apertures (13) are arranged in two sets of parallel rows arranged at right angles, where the

rows in the first set are labeled A-H and the rows in the second set are labeled 1-12 on the frame part (11) (see FIG. 1; COL. 4, lines 24-28). The apertures (13) in the second set of rows are arranged in pairs, and each pair is separated by oppositely directed, resilient arms (14) with opposite, spaced free ends (see FIGS. 2 and 3; COL. 4, lines 28-32). The latch member (15) is formed at the free end of each arm (14), which separates a pair of adjacent apertures (13), and oppositely directed towards the center of the adjacent apertures (13) (see FIGS. 2-4; COL. 4, lines 33-37). When a tube is inserted into an aperture (13) of holder (10), the latch member (15) of the arm (14) engages with the tapered outer surface part (23) of the tube (see FIGS. 2 and 4; COL. 5, lines 2-6). With an applied downward force, the surface part (23) of the tube forces the latch member (15) and its flexible arm (14) radially outward until the latch member (15) reaches the sloping annular side wall (26) of the groove (22) between the projecting parts collar (21) and outer surface part (23) (see FIGS. 3 and 4; COL. 5, lines 6-10). The latch member (15) will snap into engagement with the groove (22) under the bias of the fixed resilient arm (14) (see FIGS. 3 and 4; COL. 5, lines 6-14). While Verwohlt et al. do not disclose an open bottom side of the frame receiving an entire tube, Berthold et al show cuvette (20) entirely enclosed within the cuboid block (10) of the specimen rack (see FIG. 2, COL. 4, lines 21-25). Berthold et al. do not explicitly state why the cuvette (20) is completely enclosed; however, it appears that the enclosure provides protection for light-sensitive samples. Berthold et al. do not disclose open bottom side of the frame. Rothermel et al. do disclose a storage rack (56) with an open bottom (24) and top (22) to insert and remove a tube from either side (see FIGS. 1-7). Therefore, it would have been obvious to

one having ordinary skill in the art at the time the invention was made to modify the microtitration system of Verwohlt et al. to include an open bottom and top side of the frame to remove and insert tubes from either side and completely enclose a tube within the apertures to protect light-sensitive samples.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Quan whose telephone number is (703) 305-1947. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (703) 308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7718 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1193.

Elizabeth Quan  
Examiner  
Art Unit 1743

eq  
January 14, 2002

  
Jill Warden  
Supervisory Patent Examiner  
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